

AMENDMENT UNDER 37 C.F.R. § 1.111

U.S. Application No. 09/747,063

Attorney Docket No. ST9-99-186 / A8063

## **REMARKS**

### **I. Introduction**

Claims 1-45 are all the claims pending in the application. Claims 43-45 have been withdrawn from consideration in view of Applicants' election of Group I, of which at least claims 1-42 are directed.

Claims 1-42 have been examined and are rejected.

Specifically, claims 1, 10-12, 14-15, 24-26, 28-29, 38-40 and 42 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Yogaratnam, U.S. Patent No. 6,513,158 (hereinafter "Yogaratnam"). Claims 3-9, 18-23 and 31-37 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yogaratnam and Southgate, U.S. Patent No. 5,561,757 (hereinafter "Southgate"). Furthermore, claims 13, 27 and 41 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yogaratnam and "The Swing Tool Set" article (hereinafter "STS").

By way of overview, Applicants traverse the rejections of examined claims 1-42 as follows.

### **II. Formal Election of Group I (*i.e.*, claims 1-42)**

Applicants herein affirm the election without traverse to prosecute the invention of Group I (directed to claims 1-42), as required by the Examiner (*see* Office Action, page 3).

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### III. Claim Rejections -- 35 U.S.C. § 102(e)

Claims 1, 10-12, 14-15, 24-26, 28-29, 38-40 and 42 stand rejected under § 102(e) as allegedly being anticipated by Yogaratnam.

#### Claims 1, 15 and 29

Claim 1 recites, *inter alia*, "generating separate windows for each selected applet" and "executing each applet in a separate window" (*see also* claims 15 and 29). The Examiner alleges that Yogaratnam discloses the feature of generating separate windows for each selected applet "as seen by the four application windows being open" in Fig. 5 of Yogaratnam. Furthermore, the Examiner alleges that Yogaratnam discloses the feature of executing each applet in a separate window "as seen by the desktop" in Fig. 5 of Yogaratnam.

Yogaratnam is not at all related to executing applets in separate windows. Instead, Yogaratnam relates to running multiple Java applications simultaneously under one instance of a JVM, *i.e.*, Java Virtual Machine (Yogaratnam: Abstract). For example, Fig. 5 of Yogaratnam depicts the relationship of the hardware platform, operating system, embedded desktop, JVM, and Java applications (Yogaratnam: col. 4, lines 10-12). In Yogaratnam, an embedded desktop, which is stored in read only memory and subsequently loaded into and executed by a processor of the information appliance, allows the information appliance to run only one instance of a JVM, regardless of the number of Java applications that have been launched (Yogaratnam: col. 4, lines 13-16 and 46-51). Fig. 5 of Yogaratnam illustrates multiple Java applications (APP 1, APP 2, APP 3 . . . APP n) running under a single instance of the JVM via the embedded desktop.

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Fig. 5 of Yogaratnam does not disclose or suggest "generating separate windows for each selected applet" and "executing each applet in a separate window", as recited in claim 1 (*see also* claims 15 and 29). Indeed, Yogaratnam does not disclose or suggest that the four boxes labeled APP 1, APP 2, APP 3 and APP n, respectively, are separate windows. These boxes, like the boxes labeled Operating System, JVM and Desktop, are merely abstractions intended to illustrate multiple Java applications running with a single instance of the JVM (Yogaratnam: col. 4, lines 10-16; and Figs. 4-5). This point is further illustrated by the lines connecting the abstracted four boxes that illustrate the multiple Java applications (Yogaratnam: Fig. 5). These lines represent the ability of the Java applications to communication with each other in a system independent manner (Yogaratnam: col. 4, lines 16-18; and Fig. 5).

For at least the above exemplary reasons, claims 1, 15 and 29 are not anticipated by Yogaratnam.

Claims 10-12, 14, 24-26, 28, 38-40 and 42

Consequently, claims 10-12, 14, 24-26, 28, 38-40 and 42 are not anticipated by Yogaratnam, at least by virtue of their dependency.

**IV. Claims Rejections -- 35 U.S.C. § 103(a)**

Claims 3-9, 18-23 and 31-37

Claims 3-9, 18-23 and 31-37 stand rejected under § 103(a) as allegedly being unpatentable over Yogaratnam and Southgate.

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Since Southgate fails to cure the exemplary deficiencies of Yogaratnam set forth above for claims 1, 15 and 29, claims 3-9, 18-23 and 31-37 are patentable over a reasonable combination, if any, of Yogaratnam and Southgate, at least by virtue of their dependency.

Furthermore, the Examiner fails to establish a *prima facie* case of obviousness by providing a reasonable suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings (*see* MPEP § 2143).

The Federal Circuit has noted that the USPTO is held to a rigorous standard when trying to show that an invention would have been obvious in view of the combination of two or more references. According to the Federal Circuit, "the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references" (*see In re Sang Su Lee*, 61 USPQ2d 1433 (Fed. Cir. 2002), *citing, e.g., In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)).

Applicants respectfully submit that the current grounds of rejection do not satisfy the Federal Circuit's standard for demonstrating that the claimed invention would have been obvious in view of the combination of Yogaratnam and Southgate.

Specifically, the Examiner acknowledges that Yogaratnam fails to teach or suggest the manipulation of the windows, as recited in claims 3-9, 18-23 and 31-37 (*see* Office Action, page 5). However, the Examiner alleges that Southgate makes up for these deficiencies of Yogaratnam by describing the resizing, repositioning, minimizing, maximizing, overlapping,

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cascading and tiling of windows (Southgate: col. 1, line 58 to col. 2, line 3; and col. 3, lines 5-21).

To the contrary, the "windowing" described in Southgate (*see, e.g.*, Southgate: col. 1, line 31) is similar to the conventional "windowing" of applications, as described in Applicants' Specification at page 1, line 22 to page 2, line 2. Southgate does not teach or suggest the resizing, repositioning, minimizing, maximizing, overlapping, cascading and tiling of a window in which an applet is executing. Indeed, as noted in Applicant's Specification at page 3, lines 15-16, applets ordinarily cannot be repositioned, minimized, maximized, overlapped or resized.

Furthermore, the Examiner fails to establish a reasonable expectation of success, from the references themselves and absent impermissible hindsight, for the alleged combination of Yogaratnam and Southgate (*see* MPEP § 2143).

Thus, Applicants respectfully submit that, contrary to the Examiner's allegations, it would not have been obvious to one of ordinary skill in the art, at the time of the invention, to combine Yogaratnam and Southgate to achieve the manipulations of windows with applets executing therein (*see* claims 3-9, 18-23 and 31-37).

#### Claims 13, 27 and 41

Furthermore, claims 13, 27 and 41 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yogaratnam and "The Swing Tool Set" article (hereinafter "STS").

Since STS fails to cure the exemplary deficiencies of Yogaratnam set forth above for claims 1, 15 and 29, claims 13, 27 and 41 are patentable over a reasonable combination, if any,

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of Yogaratnam and STS, at least by virtue of their dependency. For example, STS merely describes the JInternalFrame construct (STS: page 10). STS does not teach or suggest "generating a JInternal frame for each selected applet", as recited in claim 13 (*see also* claims 27 and 41). Indeed, as noted in Applicants' Specification at page 9, lines 6-17, the purpose of the JInternalFrame is to allow one applet to have multiple documents visible. A JInternalFrame holding a document is not the same as a JInternalFrame holding an applet (*see* Applicants' Specification: page 9, lines 14-16).

## **V. Formal Matters**

### Priority

The Examiner acknowledges Applicants' claim for domestic priority under 35 U.S.C. § 119(e) to provisional application 60/172,038.

### Cited References

The Examiner provides a signed and initialed copy of the Form PTO-1449 submitted with Applicants' IDS filed on June 22, 2001. Since the Examiner failed to initial by reference number 24, Applicants respectfully request that the Examiner provide a corrected signed and initialed copy of this Form PTO-1449, thereby indicating consideration of the references cited therein.

### Drawings

The Examiner acknowledges acceptance of the drawings filed on December 22, 2000.

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Specification

The Examiner objects to the specification because "it contains an embedded hyperlink and/or other form of browser-executable code".

Applicants amend the specification to remove two instances of incorporation by reference via hyperlink, as required by MPEP § 608.01. Applicants respectfully submit that all remaining instances of hyperlinks and browser-executable code are germane to Applicants' invention and thus are permissible under MPEP § 608.01. Applicants do not intend any such hyperlinks to be active links.

**VI. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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